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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/141,264	08/27/1998	TERRELL B. JONES	7099.0003	9665

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EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

3625

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/141,264

Applicant(s)

JONES ET AL. 

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendment E, paper # 17, received on 08/26/2003, is acknowledged and entered. Claims 1, 5, 6, 20, 39, 58 and 59 have been amended. Currently claims 1-59 are pending for examination.

### ***Response to Arguments***

2. In view of the amendment to claim 59, rejection of claim 59 under 35 U.S.C. 112, second paragraph is withdrawn.

The applicant's statement, regarding the provisional double patenting rejection of claims 1-59, that he would respond at a later time such as by filing a Terminal Disclaimer is noted. Accordingly at present the rejection of claims 1-59 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 of co-pending Application No. 10/141,935 is maintained.

The Applicant's arguments (see pages 15-21) with regards to claims 1-57 are directed to the new limitation of "determining at least one mode of transportation between the intermediate point and the destination location based upon the travel goal", added to independent claims 1, 20, and 39. These arguments have been fully

considered but are moot in view of new grounds of rejection, i.e., they are obvious over DeLorme in view of Official Notice.

Regarding claims 58-59, the Applicant argues (see pages 21-22) that neither DeLorme nor the Press Release teach or suggest individually or in combination, recommending a plurality of secondary modes of transportation at the destination location by the appointment time or select modes and times of transportation based on travel goal as recited in claims 58 and 59. The examiner does not agree for the following reasons:

(i) Claims 58 and 50 do not recite teaching selection of times of transportations.

(ii) DeLorme teaches a subsystem for selection of a plurality of secondary modes of transportation (see at least col.21, lines 58-66, where, DeLorme discloses that TRIPS, the software program can help users to select and output updated information on topic places and events including secondary modes of ground transportation or travel such as walking, subways, biking, etc.).

(iii) The examiner acknowledged in the previous office action that DeLorme did not expressly disclose recommending one or more modes of ground transportation to a destination site. However, the Press release in the same field of traveling, teaches the use of an automatic system for recommending alternative modes of ground transportation to the travelers, "by bus or train to selected destinations" based upon information, such as expected delays and fares to the consumers. In view of the Press release, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to modify DeLorme to incorporate the feature of Press

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release. Doing so would allow recommending alternative mode of ground transportation by bus or train to reach destination point and further enable the travelers to select a mode of transportation based upon their preference related to the time calculation/expected delay and fare.

This is a final rejection

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 of co-pending Application No. 10/141,935. Although the conflicting claims are not identical, they are not patentably distinct from each other. The only difference in the claims 1-57 of both the applications is that claim limitations in the instant application include the phrase "that allows time for traveling between the intermediate point and the

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destination location". This property would be inherent in the existing claim of the co-pending application ' 935, while determining an arrival time and a secondary mode of transportation within a vicinity of the destination location using the located travel information to ensure arrival at the destination location by the appointment time.

The only difference between claim 58 of both the applications is that the co-pending application '935 does not include the phrase, " to ensure arrival at the destination location by the appointment time. However, this limitation would be obvious over the existing claim of the co-pending application ' 935 while recommending a plurality of travel options and recommending a plurality of secondary modes of transportation based on the travel goal to reach the destination location at an appointed time.

The only difference between claim 59 of both the applications is that the co-pending application '935 includes the phrase " select ground transportation " instead of "recommend one or more modes of ground transportation " as included in the instant application. However, the limitation of recommending one or more ground transportation would be obvious over the existing claim of the co-pending application ' 935 to enable the user to select one of the modes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-57 are rejected under 35 U.S.C. 103(a) as being obvious over DeLorme and in view of, Official Notice.

Regarding claim 1, DeLorme discloses a data processing system for processing travel requests using a travel database, comprising:

a memory including program instructions (column 14, lines 53-65); and a processor operating responsive to the program instructions to (column 14, lines 53-65):

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receive a travel goal specifying a destination location and an appointment time for arrival at the destination location (column,17, line 62-column,18, line 12, column 23, lines 14-63; column 26, lines 29-55; and column 40, lines 54-55; column 50, lines 30-35);

access the travel database to locate travel information corresponding to the destination location (column 13, line 48-column 14, line 52); and

determine an arrival time at an intermediate point within a vicinity of the destination location using the located travel information to ensure arrival at the destination location by the appointment time (column 8, lines 33-39,column34, line 57-column 35, line 8, column 40, line 57-column 41, line 5, column 51, lines 31-36 and column 19, lines 39-58).

DeLorme does not expressly disclose determining one mode of transportation between the intermediate point and the destination location based upon the travel goal. The examiner takes an Official Notice that determining manually one mode of transportation between the intermediate point and the destination location based upon the travel goal is old and well established in the field of traveling. For example, If a traveler who has to travel to Washington D.C. from New York, would inherently determine as which secondary mode of transport, such as taxi, private pick-up, metro, metro-bus, walking, rental-car, etc. would suit him based upon the cost and time available with him to reach his destination point in the city at the appointed time. A destination point could be an office for a meeting, a tourist spot, a residence, etc. depending upon his travel goal.

It was also known at the time of the applicant's invention that merely providing an automatic means to replace a manual activity, which accomplishes the same result is not sufficient to distinguish over the prior art. Factors and considerations dictated by law governing 35 U.S.C. 103 apply without modification to computer-related inventions. Moreover, merely using a computer to automate a known process does not by itself impart nonobviousness to the invention. See *Dann v. Johnston*, 425 U.S. 219, 227-30, 189 USPQ 257, 261 (1976); *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of determining one mode of transportation between the intermediate point and the destination location based upon the travel goal from a customer gives you just what you would expect from the manual step as shown in Official Notice above. In other words, there is no enhancement found in the claimed step. Automation can simply determine it faster but the result is the same.

In view of Official Notice, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to incorporate the old and well-known step, with automation, to determine a secondary mode of transport, such as taxi, private pick-up, metro, metro-bus, walking, rental-car, etc. to reach his destination point. Doing so would enable the traveler to select a mode of transport that would suit him best based upon the cost and time available to him to reach his destination point in the city at the appointed time.

Regarding claim 2, DeLorme further discloses a plurality of travel stations are within the vicinity of the destination location, and wherein the processor further operates responsive to the program instructions to:

select one of the plurality of travel stations (column 18, line 58-column 19, line 8); and determine available modes of transportation between the selected travel station and the destination location (column 8, lines 33-58).

Regarding claim 3, DeLorme further discloses the processor further operates responsive to the program instructions to:

display the available modes of transportation (column 23, lines 45-63); and receive a selection of one of the available modes of transportation (column 18, line 58-column 19, line 8).

Regarding claim 4, DeLorme further discloses the travel information includes a plurality of travel options available at the travel station, and wherein the processor further operates responsive to the program instructions to:

select one of the plurality of travel options that arrives at the travel station at the time of arrival sufficient to ensure arrival at the destination location by the appointment time (column 17, lines 44-60).

Regarding claim 5, DeLorme further discloses the processor further operates responsive to the program instructions to display data listing the plurality of travel

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options (column 25, lines 35-65); and receives an indication of a selected travel conveyance (column 40, lines 38-56).

Regarding claim 6, DeLorme further discloses the processor further operates responsive to the program instructions to:

display data listing the plurality of travel options (column 25, lines 35-65); and receive an indication of a selected travel flight (column 40, lines 48-50).

Regarding claim 7, DeLorme further discloses the instructions to maintain a profile of travel preferences, wherein the travel option section is based on the travel preferences (column 61, lines 10-26).

Regarding claim 8, DeLorme further discloses the processor further operates responsive to the program instructions to:

receive a travel return date (column 51, line 23-column 52, line 23); and display a list of return travel options from the travel station on the travel return date (column 51, line 23-column 52, line 23).

Regarding claim 9, DeLorme further discloses the processor further operates responsive to the program instructions to:

determine whether an overnight stay is required (column 17, lines 55-58 and column 18, lines 48-51); and display a list of hotels for selection (column 22, lines 43-51).

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Regarding claim 10, DeLorme further discloses the processor further operates responsive to the program instructions to:

receive a selection of one of the hotels (column 74, lines 20-25); and reserve a room at the selected hotel (column 74, lines 20-25).

Regarding claim 11, DeLorme further discloses the processor further operates responsive to the program instructions to locate restaurants in a vicinity of the destination site (column 49, line 60-column 50, line 26).

Regarding claim 12, DeLorme further discloses the processor further operates responsive to the program instructions to search a restaurant database for restaurants in the vicinity of the destination location (column 48, lines 47-67).

Regarding claim 13, DeLorme further discloses the processor further operates responsive to the program instructions to locate restaurants includes an instruction to display the determined restaurants (column 50, lines 27-67).

Regarding claim 14, DeLorme further discloses the processor further operates responsive to the program instructions to locate activities in a vicinity of the destination location (see figures 7A and 7B).

Regarding claim 15, DeLorme further discloses the processor further operates responsive to the program instructions to: search an activities database for the activities in the vicinity of the destination location (column 30, lines 1-17).

Regarding claim 16, DeLorme further discloses the processor further operates responsive to the program instructions to: locate activities includes an instruction to display a list of the determined activities (figures 7A and 7B).

Regarding claim 17, DeLorme further discloses the processor further operates responsive to the program instructions to provide travel information in accordance with the determined arrival time (column 17, lines 14-43).

Regarding claim 18, DeLorme further discloses the travel information includes geographic data for travel between the travel station and the destination (figures 1B-1C).

Regarding claim 19, DeLorme further discloses the travel goal may include a plurality of legs of travel each leg of travel including a different destination location and appointment time for arrival at the destination location (column 44, lines 43-61).

Claims 20-38 are written in computer software with parallel limitations found in claims 1-19, therefore are rejected as obvious over DeLorme in view of the Official Notice by the same rationale.

Claims 39-57 are written in function method with parallel limitations found in claims 1-19, therefore are rejected as obvious over DeLorme in view of the Official Notice by the same rationale.

7. Claims 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme and further in view of, Press release.

Regarding claim 58, DeLorme discloses a method for processing travel requests including the steps of:

receiving a travel goal including a destination location and an appointment time (column, 17, line 62-column, 18, line 12, column 23, lines 14-63; column 26, lines 29-55; and column 40, lines 54-55; column 50, lines 30-35);

recommending a plurality of travel options and recommending a secondary mode of transportation based on the travel goal to ensure arrival at the destination location by the appointment time (column 17, lines 44-60; column 40, lines 38-56 and figures 7A-7B, column 8, lines 33-39, column 34, line 57-column 35, line 8, column 40, line 57-column 41, line 5, column 51, lines 31-36 and column 19, lines 39-58. Note: car rentals correspond to the secondary mode of transportation).

invoking a transportation decision system to select one of the plurality of travel options and a secondary mode of ground transportation based on the recommended

travel options and the recommended secondary ground transportation (column 14, lines 19-43, col.21, lines 63-66, col.23, lines 56-63);

determining whether an overnight stay is required (column 17, lines 55-58 and column 18, lines 48-51);

invoking a hotel decision support system to select a hotel when it is determined that an overnight stay is required (figures 7A-7B); and

invoking an activity and restaurant decision support system to select activities and restaurants in a vicinity of the destination location (figures 7A-7B).

DeLorme further teaches selection of a plurality of secondary modes of transportation, see col.21, lines 63-66, col.23, lines 56-63. TRIPS discloses other modes of transportation like, walking, subway, biking, plane, car, public transport which can be made available to the user to select.

DeLorme does not disclose recommending a plurality of second modes of transportation to ensure arrival at the destination location by the appointment time. However, Press release, teaches recommending alternative transportation modes to passengers on interactive terminals (see the entire article, "*.....The system will also recommend alternative transportation modes and routes to passengers*"). By recommending alternative plurality of transportation modes like buses and trains the system will be able to provide the best information on expected delays, arrival times of the busses and enabling the passengers to calculate transit routes both by bus and train to their selected destinations. In view of the Press release, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified

DeLorme to include recommending alternative ground transportation modes to the user to enable him calculate the transit route and select the one as per his preference , his budget and the time available to reach his destination.

Regarding claim 59, DeLorme discloses a memory for access by a computer including:

- a travel goal subsystem for receiving a travel goal including a destination location and an appointment time (column,17, line 62-column,18, line 12, column 23, lines 14-63; column 26, lines 29-55; and column 40, lines 54-55; column 50, lines 30-35);

- a transportation subsystem having instructions to select modes and times of transportation based on the travel goal (figures 2, items 221 and 223);

- a hotel subsystem having instructions to select hotel in a vicinity of a destination site (figure 2, item 213);

- activity and restaurant subsystem having instructions to select activities or restaurants near a destination site (figure 2, item 213);

DeLorme further teaches a subsystem for selection of a plurality of secondary modes of transportation, see col.21, lines 63-66, col.23, lines 56-63. TRIPS discloses other modes of transportation like, walking, subway, biking, plane, car, public transport which can be made available to the user to select. DeLorme does not disclose a ground transportation subsystem having instructions to recommend one or more modes of ground transportation to a destination site. However, Press release, teaches ground transportation subsystem having instructions to recommend one or more modes of

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ground transportation to a destination site to passengers on interactive terminals (see the entire article, "*.....The system will also recommend alternative transportation modes and routes to passengers*"). By recommending one or more modes of ground transportation like buses and trains, the system will be able to provide the best information on expected delays, arrival times of the busses and enabling the passengers to calculate transit routes by both bus and train to their selected destinations. In view of the Press release, it would be obvious to a person of an ordinary skill in the art at the time of the invention to modify DeLorme to include recommending one or modes of transportation to the user to enable him calculate the transit route and select the one as per his preference, his budget and time available to reach his destination point.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

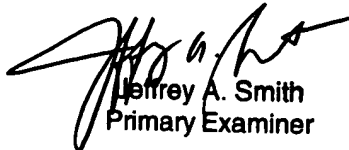
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg  
Examiner  
Art Unit 3625

YCG  
November 9, 2003

  
Jeffrey A. Smith  
Primary Examiner